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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,917	05/22/2001	Michael Jarman	78104.073	8732
25005	7590	04/06/2010	EXAMINER	
Intellectual Property Dept. Dewitt Ross & Stevens SC 2 East Mifflin Street Suite 600 Madison, WI 53703-2865			BORISOV, IGOR N	
			ART UNIT	PAPER NUMBER
			3628	
			NOTIFICATION DATE	DELIVERY MODE
			04/06/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket-ip@dewittross.com

Office Action Summary	Application No.	Applicant(s)	
	09/862,917	JARMAN ET AL.	
	Examiner	Art Unit	
	IGOR BORISOV	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 29 January 2010.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-21,23-26,28,37-39,41-43 and 45-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-21, 23-26, 28, 37-39, 41-43 and 45-48 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Response to Amendment

Amendment received on 01/05/2010 is acknowledged and entered. Claims 22, 27, 29-36, 40 and 44 have been canceled. Claims 1-21, 23-26, 28, 37, 38, 41, 42, 43 and 45 have been amended. New claims 46-48 have been entered. Claims 1-21, 23-26, 28, 37-39, 41-43 and 45-48 are currently pending in the application.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 45 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

A claimed process is eligible for patent protection under 35 U.S.C. § 101 if:

"(1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. See Benson, 409 U.S. at 70 ('Transformation and reduction of an article 'to a different state or thing' is the clue to the patentability of a process claim that does not include particular machines'); Diehr, 450 U.S. at 192 (holding that use of mathematical formula in process 'transforming or reducing an article to a different state or thing' constitutes patent-eligible subject matter); see also Flook, 437 U.S. at 589 n.9 ('An argument can be made [that the Supreme] Court has only recognized a process as within the statutory definition when it either was tied to a particular apparatus or operated to change materials to a 'different state or thing''); Cochrane v. Deener, 94 U.S. 780, 788 (1876) ('A process is...an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.').⁷ A claimed process involving a fundamental principle that uses a particular machine or apparatus would not pre-empt uses of the principle that do not also use the specified machine or apparatus in the manner claimed. And a claimed process that transforms a particular article to a specified different state or thing by applying a fundamental principle would not pre-empt the use of the principle to transform any other article, to transform the same article but in a manner not covered by the claim, or to do anything other than transform the specified article." (*In re Bilski*, 88 USPQ2d 1385, 1391 (Fed. Cir. 2008))

Also noted in *Bilski* is the statement, "Process claim that recites fundamental principle, and that otherwise fails 'machine-or-transformation' test for whether such

claim is drawn to patentable subject matter under 35 U.S.C. §101, is not rendered patent eligible by mere field-of-use limitations; another corollary to machine-or-transformation test is that recitation of specific machine or particular transformation of specific article does not transform unpatentable principle into patentable process if recited machine or transformation constitutes mere ‘insignificant post-solution activity.’” (*In re Bilski*, 88 USPQ2d 1385, 1385 (Fed. Cir. 2008)) Examples of insignificant post-solution activity include data gathering and outputting. Furthermore, the machine or transformation must impose meaningful limits on the scope of the method claims in order to pass the machine-or-transformation test. Please refer to the USPTO’s “Guidance for Examining Process Claims in view of *In re Bilski*” memorandum dated January 7, 2009,

http://www.uspto.gov/web/offices/pac/dapp/opla/documents/bilski_guidance_memo.pdf .

It is also noted that the mere recitation of a machine in the preamble in a manner such that the machine fails to patentably limit the scope of the claim does not make the claim statutory under 35 U.S.C. § 101, as seen in the Board of Patent Appeals Informative Opinion *Ex parte Langemyr et al.* (Appeal 2008-1495),
<http://www.uspto.gov/web/offices/dcom/bpai/its/fd081495.pdf> .

Claim 45 are not tied to a particular machine or apparatus nor do they transform a particular article into a different state or thing, thereby failing the machine-or-transformation test; therefore, claim 45 is non-statutory under § 101.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12, 14-21, 23, 28, 37-39, 41-43, 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Synesiou et al. (US 5,959,549) in view of Sloan et al. (US 5,146,067) and further in view of Davis et al. (US 6,282,522).

Independent claims

Claims 1, 37, 42 and 46. Synesiou et al. (Synesiou) teaches a utility transaction authorization system, comprising:

a financial institution (the issuer of the credit card) (C. 5, L. 55-56);

a user interface unit (display unit) separate and space from the financial institution and capable of accepting a card charge authorization (C. 5, L. 15-24, 44-60);

a utility meter (remote measurement module 38 separately located) provided at a location having an associated location identifier (unique identification number) unique to the location (C. 4, L. 16, 30-36);

wherein the utility meter (remote measurement module 38) is arranged to:

communicate with the user interface unit (display unit), to obtain a card charge authorization (C. 5, L. 55-57);

to transmit a credit/charge card charge request to a financial institution based on the card charge authorization (C. 5, L. 52-57) and meter location identifier (the utility meter unique identification number and module address code is stored in microcontroller 68, which allows the consumption data derived from a particular consumer site to be related to that site and to the credit data corresponding to that site) (C. 4, L. 49-53),

the card charge request including:

(1) data identifying a credit/charge card account (C. 5, L. 55-57), and

(2) data related to the credit/charge card (a card number and a secret code or PIN allocated to the consumer) (C. 5, L. 53-54),

to obtain authorization of the card charge from the financial institution (C. 5, L. 52-57).

Synesiou does not specifically teach that said data related to the credit/charge card is data indicating that the credit/charge card is physically present at the location of

the user interface unit. Also, Synesiou does not teach that the financial institution processes the card charge request from the utility meter regardless of whether the card charge request relates to any utility usage measurements made by the utility meter.

Sloan et al. (Sloan) teaches a prepayment system for dispensing utilities using mag-stripe cards, including a means for reading a mag-stripe card provided at the customer's side (premises) for allowing to dispense utility services in accordance with the value and account information encode' on the mag-stripe card (Cls. 3, 4), wherein the fact of using the mag-card (obtaining data from the mag-card) at the customer premises indicates that the mag-card (credit/charge card) is physically present at the location of the user interface unit.

In this case, each of the elements of the cited references combined by the Examiner performs the same function when combined as it does in the prior art. Thus, such a combination would have yielded predictable results. See *Sakraida*, 425 U.S. at 282, 189 USPQ at 453. Therefore, Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* (KSR, 82 USPQ2d at 1396) forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *Ex arte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

Davis et al. (Davis) teaches an Internet payment arrangement wherein a user purchases goods or services over the Internet by employing his/her credit card and credit card reader installed at the user's premises (Abstract; Fig. 10), wherein it appears that the financial institution processes the card charge request regardless of whether the card charge request relates to any utility usage measurements.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Synesiou and Sloan to include that the financial institution processes the card charge request from the utility meter regardless of whether the card charge request relates to any utility usage measurements, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one

of ordinary skill in the art would have recognized that the results of the combination were predictable. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

Claims 28. Synesiou teaches a utility transaction authorization method, comprising:

providing a user interface unit (display unit) at a location (C. 5, L. 15-24, 44-60);

providing a utility meter at the location, the utility meter having an associated meter location identifier uniquely identifying the location (C. 4, L. 16, 30-36);

accepting a funds card charge authorization request via the user interface unit (C. 5, L. 52-57), the transaction authorization request including:

(1) data identifying a credit/charge card account (C. 5, L. 55-57), and

(2) data identifying the credit/charge card account of the credit/charge card (C. 5, L. 55-57),

communicating the card charge authorization request from the user interface unit to the utility meter (C. 5, L. L. 34-37); and

transmitting a message generated in dependence on the card charge authorization request (C. 5, L. 52-57) and meter location identifier (the utility meter unique identification number and module address code is stored in microcontroller 68, which allows the consumption data derived from a particular consumer site to be related to that site and to the credit data corresponding to that site) (C. 4, L. 49-53) from the utility meter to a financial institution to obtain authorization of the card charge (C. 5, L. 52-57).

Synesiou does not specifically teach that said data related to the credit/charge card is data indicating that the credit/charge card is physically present at the location of the user interface unit. Also, Synesiou does not teach that the financial institution processes the card charge request from the utility meter regardless of whether the card charge request relates to any utility usage measurements made by the utility meter.

Sloan teaches a prepayment system for dispensing utilities using mag-stripe cards, including a means for reading a mag-stripe card provided at the customer's side (premises) for allowing to dispense utility services in accordance with the value and

account information encode' on the mag-stripe card (Cl. 3, 4), wherein the fact of using the mag-card (obtaining data from the mag-card) at the customer premises indicates that the mag-card (credit/charge card) is physically present at the location of the user interface unit.

In this case, each of the elements of the cited references combined by the Examiner performs the same function when combined as it does in the prior art. Thus, such a combination would have yielded predictable results. See *Sakraida*, 425 U.S. at 282, 189 USPQ at 453. Therefore, Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* (KSR, 82 USPQ2d at 1396) forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision Ex arte Smith, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

Davis teaches an Internet payment arrangement wherein a user purchases goods or services over the Internet by employing his/her credit card and credit card reader installed at the user's premises (Abstract; Fig. 10), wherein it appears that the financial institution processes the card charge request regardless of whether the card charge request relates to any utility usage measurements.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Synesiou and Sloan to include that the financial institution processes the card charge request from the utility meter regardless of whether the card charge request relates to any utility usage measurements, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

Claims 43, 45 and 47. Synesiou teaches a utility transaction authorization system, comprising:

a utility meter (remote measurement module 38) provided at a location having an associated location identifier (unique identification number) unique to the location (C. 4, L. 16, 30-36);

a user interface unit (display unit) capable of accepting a card charge authorization (C. 5, L. 15-24, 44-60);

said user interface unit: includes means for inputting credit card information (C. 5, L. 55-58);

communicating with the utility meter to obtain the location identifier (C. 4, L. 16-36);

processing the data read from the credit/charge card in combination with the location identifier to form at least a part of the funds transfer authorization to verify that the credit/charge card is physically present at the location of the utility meter (C. 5, L. 52-57), meter location identifier (the utility meter unique identification number and module address code is stored in microcontroller 68, which allows the consumption data derived from a particular consumer site to be related to that site and to the credit data corresponding to that site) (C. 4, L. 49-53), and a secret code or PIN allocated to the consumer (C. 5, L. 53-54)).

Synesiou does not specifically teach that said means for inputting credit card information includes a card reader device.

Sloan teaches a prepayment system for dispensing utilities using mag-stripe cards, including a means for reading a mag-stripe card provided at the customer's side (premises) for allowing to dispense utility services in accordance with the value and account information encode' on the mag-stripe card (Cl. 3, 4).

In this case, each of the elements of the cited references combined by the Examiner performs the same function when combined as it does in the prior art. Thus, such a combination would have yielded predictable results. See *Sakraida*, 425 U.S. at 282, 189 USPQ at 453. Therefore, Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* (KSR, 82 USPQ2d at 1396) forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See

the recent Board decision *Ex arte Smith*, --USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007).

Davis teaches an Internet payment arrangement wherein a user purchases goods or services over the Internet by employing his/her credit card and credit card reader installed at the user's premises (Abstract; Fig. 10), wherein it appears that the financial institution processes the card charge request regardless of whether the card charge request relates to any utility usage measurements.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Synesiou and Sloan to include that the financial institution processes the card charge request from the utility meter regardless of whether the card charge request relates to any utility usage measurements, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

Dependent claims

Claims 2-4, 7, 8-12. Synesiou teaches a communication unit arranged to communicate with the utility and the financial institution (C. 5, L. 52-57).

Claims 5 and 6. Synesiou teaches said system in which said further meter is a gas or water meter (Fig. 5).

Claims 14-16. Synesiou teaches said system in which RF signals are utilized for communication between communication devices (C. 5, L. 34-37).

Claims 17-21, 23, 38-39, 41. Same reasoning as applied to independent claims 1, 35 and 37.

Claims 13, 24-26 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Synesiou et al. in view of Sloan et al. further in view of Davis et al. and further in view of Bos (WO 00/58922).

Dependent claims

Claim 13. The combination of Synesiou and Sloan in view of Official Notice teaches all the limitations of claim 13, except that the user interface unit is a telephone.

Bos teaches a utility transaction authorization system, including a meter and a digital cellular phone which is used by a consumer to obtain payment authorization (Fig. 1; Abstract).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combination to include that the user interface unit is a telephone, as disclosed in Bos, because it would advantageously allow to combine various functionalities in one mobile device, thereby providing convenience to the user.

Claims 24-26 and 48. Same reasoning as applied to claim 13.

Response to Arguments

Applicant's arguments with respect to claims 1-21, 23-26, 28, 37-39, 41-43 and 45-48 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Igor N. Borissov/
Primary Examiner, Art Unit 3628
03/30/2010